Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GILAD ODINAK and NIGEL S. KEAM

Appeal No. 2001-2030
Application No. 08/874,046

ON BRIEF

Before HAIRSTON, KRASS and RUGGIERO, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-6, 8-24, 26, 27 and 35-51.

The invention pertains to home control systems whereby home appliances are controlled by utilizing existing AC power distribution wires in the home. In particular, the invention allows component groups of appliances to utilize different

communication protocols, data exchange formats and/or command sets. Unlike conventional home control system data protocols, the inventive communication system does not address individual electronic appliances, but, instead, addresses entire component groups using a group identifier code.

Representative independent claim 1 is reproduced as follows:

1. A home control system that uses electrical power lines for communications, comprising:

a plurality of components that are connectable for communications among themselves through the electrical power lines, said components including groups of components, wherein each group is identified collectively by a particular group identifier code;

components of any particular group being configured to compose and send messages according to a protocol that differs from a protocol employed by another group of components, wherein the messages include the group identifier code of their particular group;

components of any particular group being further configured to receive messages from components of different groups and to disregard messages that include a group identifier code different than the group identifier code of their particular group.

The examiner relies on the following references:

Guidette et al. (Guidette)	5,227,762	Jul. 13, 1993
Bertsch	5,570,085	Oct. 29, 1996
Dykema et al. (Dykema)	5,661,804	Aug. 26, 1997 (filed Jun. 27, 1995)

Claims 1-6, 8-24, 26, 27 and 35-51 stand rejected under 35 U.S.C. 103. As evidence of obviousness, the examiner cites Bertsch and Guidette with regard to claims 1-3, 6, 8, 9, 21-24 and 27,[1] adding Dykema to this combination with regard to claims 4, 5, 10-20, 26 and 35-51.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

At the outset, we note that appellants have placed the claims into three groups (principal brief-page 7):

I. Claims 1, 2, 10, 11, 13, 15, 16, 21, 22.

II. Claims 6, 8, 14, 20, 24.

III. Claims 3-5, 9, 12, 17-19, 23, 26, 27 and 35-51.

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[1]The examiner includes claim 25 in this group in the rejection but claim 25 is not on appeal in this case in accordance with appellants' grouping of the claims at page 7 of the principal brief, appellants' failure to include claim 25 in the appendix of claims attached to the principal brief, the cancellation of the claim in the amendment of December 6, 1999 and appellants' omission of that claim in the listing of the dependent claims which are deemed patentable at page 19 of the principal brief. Moreover, the examiner agreed that the copy of the appealed claims contained in the appendix to the principal brief "is correct" [answer-page 3].

Accordingly, we will take claim 1 as representative of group I, claim 6 as representative of group II, and claim 35 as representative of group III.

In rejecting claims under 35 U.S.C. 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v, John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason much stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc. , 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR 1.192 (a)].

With regard to claim 1, the examiner contends that Bertsch discloses a programmable distributed appliance control system utilizing an electric power line for the transmission medium. The examiner further contends that Bertsch's disclosure of a system configuration relative to message handling "fairly implies composing, sending, receiving, and disregarding such messages" [answer-page 3]. The examiner recognizes that Bertsch does not

expressly disclose the use of an identifier which collectively identifies a group of components but the examiner contends that Bertsch "implies" such claim limitations wherein different groups of the components use different formats for the data portion by teaching that his "CEBUS message is automatically translated to a signal format that is appropriate for the capabilities of the appliance," citing column 4, lines 42-44, of Bertsch at page 4 of the answer.

Thus, the examiner finds that Bertsch implies that different appliances have different formats.

The examiner turns to Guidette for the teaching of using an identifier which collectively identifies a group of components to enable communication between components and to enable the control of a plurality of components in a home bus system, concluding that it would have been "obvious...to have utilized the group identifying concept of Guidette in the Bertsch system to provide simple control of a plurality of components together" [answer-page 4].

With regard to claim 6, the examiner argues that Bertsch explicitly or implicitly meets the claim limitation of "the messages include data portions, and wherein different groups of the components use different formats for the data portions" by

the "teachings relative to the first sublayer within his layer 2 which 'includes the arrangement of data bytes for identifying the type of packet, the data content of the packet, and special bytes for assisting the detection and correction of transmission errors' as used to communicate with his different consumer appliances 80A, 80B, etc. (col. 4, lines 15-20)" [answer-page 5].

With regard to claim 35, the examiner argues that the scope of this claim is "the same as or broader than that of claims 1-9 in every way" [answer-page 8] and concludes that the same reasoning applied with regard to claim 1 would be equally applicable to independent claim 35.

We REVERSE.

The fatal flaw in the examiner's case, as we view it, is in the examiner's contention that Bertsch implies that different appliances have different formats and that, somehow, Bertsch relates to components of a particular group being configured to compose and send messages according to a "protocol that differs from a protocol employed by another group of components," as claimed.

As clearly pointed out by appellants in both the principal

and reply briefs, Bertsch is directed to a conventional programmable distributed appliance control system over which the instant invention is an improvement. That is, Bertsch addresses individual electronic appliances by the use of a *single* protocol, rather than allowing component groups to utilize different communication protocols, data exchange formats and/or command sets.

While the examiner finds different protocols in Bertsch in the statement, by Bertsch, that a CEBUS message is automatically translated to a signal format "that is appropriate for the capabilities of the appliance," at column 4, lines 42-44, of Bertsch, we agree with appellants that CEBUS is a single protocol, i.e., a set of conventions governing the format of message exchange between two communications terminals and there is no evidence of record that the CEBUS protocol is itself formed by a plurality of protocols [reply brief-page 3]. We further agree with appellants that it is not reasonable to say that each different command or data format used within a protocol, such as CEBUS, is itself a protocol, as the examiner appears to be arguing.

Accordingly, since independent claim 1 and, by extension, dependent claim 6, both require "components of any particular

group being configured to compose and send messages according to a protocol *that differs from a protocol* employed by another group of components..." [emphasis added], and this is not taught by either Bertsch (upon which the examiner relies for such a teaching) or Guidette (upon which the examiner relies for the teaching of a group identifier code), or by Dykema (upon which the examiner relies for changing key values in claims 4, 5, 10-20, 26 and 35-51), we will not sustain the rejections of claims 1, 2, 6, 8, 10, 11, 13-16, 20-22 and 24 under 35 U.S.C. 103.

With regard to claim 35, while this claim does not contain the exact same language as claim 1, it is clear that claim 35 requires components to belong to particular groups and that messages are sent between components within that group according to a protocol common to that group of components. The claim also requires first and second message authentication codes which are calculated, in part, from a key value shared between sending and receiving components. Since the examiner is basing the rejection of this claim on the reasoning applied to claim 1, it is not clear how the examiner is treating these additional requirements of claim 35 and, accordingly, no prima facie case of obviousness has been established by the examiner. We note that the examiner makes no argument regarding the use of multiple protocols

possibly not being required by claim 35. Accordingly, since both appellants and the examiner apparently believe that the use of multiple, different protocols is required by independent claim 35 and other claims of group III, we will interpret such claims as requiring multiple, different protocols. Since we find that none of the applied references suggest such different protocols, we also will not sustain the rejection of claims 3-5, 9, 12, 17-19, 23, 26, 27 and 35-51, of group III, under 35 U.S.C. 103.

The examiner's decision, rejecting claims 1-6, 8-24, 26, 27 and 35-51 under 35 U.S.C. 103, is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
ERROL A. KRASS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH F. RUGGIERO Administrative Patent Judge	)	

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